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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/590,044	05/02/2007	Thomas Kuenzi	10139/04402	5598
76960	7590	12/14/2009		
Fay Kaplun & Marcin, LLP 150 Broadway, suite 702 New York, NY 10038			EXAMINER WAGGLE, JR, LARRY E	
			ART UNIT 3775	PAPER NUMBER
			MAIL DATE 12/14/2009	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/590,044

Applicant(s)

KUENZ ET AL.

Examiner

Larry E. Waggle, Jr

Art Unit

3775

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 August 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 August 2006 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/GS/US)
Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Drawings

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the "recess" as in claim 9 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: in addition to showing the "recess" as in claim 9 in the drawings, reference to the limitation must be disclosed in the specification without the addition of new matter.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 11-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 11 recites the limitation "the point of emergence," "the distal, angle-stable screws," and "the distal bone screw." There is insufficient antecedent basis for these limitations in the claim.

Claim 13 recites the limitation "the bow" and "the contact element." There is insufficient antecedent basis for these limitations in the claim.

Claim Rejections - 35 USC § 102

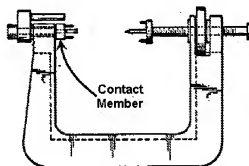
The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-2 and 8-9 are rejected under 35 U.S.C. 102(b) as being anticipated by Saunders et al. (EP 132284 A1).

Saunders et al. disclose an aiming device comprising a U-shaped bow (1) having at least one contact element (i.e. member including 7; see annotated Figure below) at a first end of the bow and, at a second end of the bow a screw spindle (5) movable towards and away from the contact element and having a rotary grip (4; i.e. nut) mounted in a recess of the bow and pin (3); and a drill bushing (12), wherein the drill bushing is removably inserted (via 13) through the contact element and a bone compression produced by the bow persisting after removal of the drill bushing (Figures 1-2 and page 4, lines 1 – page 5, line 10).



With regard the statements of intended use and other functional statements, such as “for” and “configured for,” they do not impose any structural limitations on the claims distinguishable over Saunders et al. in view of Sher et al. which are capable of being used as claimed if one so desires to do so. *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Furthermore, the law of anticipation does not require that the reference “teach” what the subject patent teaches, but rather it is only necessary that the claims under attack “read on” something in the

reference. *Kalman v. Kimberly Clark Corp.*, 218 USPQ 781 (CCPA 1983). Furthermore, the manner in which a device is intended to be employed does not differentiate the claimed apparatus from the prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over *Saunders et al.* (EP 132284 A1) in view of *Sher et al.* (US Patent 4364381).

Saunders et al. disclose the claimed invention except for the contact element being a rotationally movable adaptor bushing. *Sher et al.* teach an aiming device (10) comprising a locking member (18; i.e. clamp) at one end and a rotationally movable

adaptor bushing (16) at the other end. It would have been obvious to a person having ordinary skill in that art at the time of the invention to construct the invention of Saunders et al. with the aiming device comprising a locking member at one end and a rotationally movable adaptor bushing at the other end in view of Sher et al. in order to accommodate for moving of the contact member relative to the bone to conform to the bone while clamping.

Claims 4-5 and 14-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Saunders et al. (EP 132284 A1) in view of Sher et al. (US Patent 4364381) in further view of Gotfried (US Patent 4465065).

Saunders et al. in view of Sher et al. disclose the claimed invention except for the adaptor bushing forming a plug connection with a target plate which can be screwed onto an implant and the drill bushing being caused to engage the implant. Gotfried teach a target plate (I) capable of being screwed (via 13) onto an implant (II) prior to a targeting procedure (Figures 2-4 and column 4, line 13 - column 5, line 46). A skilled artisan would recognize the benefit of threading the outside of the drill bushing to match the screw (13) to engage the implant (II) and to fashion the adaptor bushing to form a plug connection with the hole through the arm (11) of the target plate (I) and then using the aiming device to clamp the bone implant and target plate to the fragmented bone. It would have been obvious to a person having ordinary skill in that art at the time of the invention to construct the invention of Saunders et al. in view of Sher et al. with the adaptor bushing forming a plug connection with a target plate which can be screwed onto an implant and the drill bushing being caused to engage the implant in view of

Gotfried in order to provide further guiding means to precisely locate the implant with respect to the fractured bone.

Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Saunders et al. (EP 132284 A1) in view of Pinkous (US Patent 5893553). Saunders et al. disclose the claimed invention except for the bow being in the form of a lattice structure or having various cut-outs. Pinkous teaches the use of recesses (20) in a clamping device (Figure 1 and column 2, lines 38-40); however fails to disclose various cut-outs. It would have been obvious to a person having ordinary skill in that art at the time of the invention to construct the invention of Saunders et al. in view of Pinkous with various cut-outs in order to lighten the overall weight of the device, since the applicant has not disclosed that such is anything more than one of numerous shapes or configurations a person ordinary skill in the art would find obvious for the purpose of providing a forming edge in the heating portion or clamp. In re Dailey and Eilers, 149 USPQ 47 (1966).

Claims 6 and 11-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Saunders et al. (EP 132284 A1) in view of Sher et al. (US Patent 4364381) in further view of Gotfried (US Patent 4465065) and in further view of Davison (US Patent 4710075).

Saunders et al. in view of Sher et al. in further view of Gotfried disclose the claimed invention except for a scale being mounted on the screw spindle or on an element firmly connected to or engaging the screw spindle. Davison teaches a scale (i.e. numerical indicators 22 provided relative to axially spaced grooves 20) mounted on

a drill assembly (10) (Figures 1-2 and column 4, lines 19-30). It would have been obvious to a person having ordinary skill in that art at the time of the invention to construct the invention of Saunders et al. in view of Sher et al. in further view of Gotfried with the scale mounted on the screw spindle in view of Davison in order to accurately determine the length of the drill bit and further the length of a screw received in the drilled hole.

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Saunders et al. (EP 132284 A1) in view of Sher et al. (US Patent 4364381) in further view of Gotfried (US Patent 4465065) and in further view of Davison (US Patent 4710075) and in further view of Bliss (US Patent 5713117).

Saunders et al. in view of Sher et al. in further view of Gotfried and in further view of Davison disclose the claimed invention except for the pin mounted on the screw spindle being changeable. Bliss teach a cylindrical body (42) that is changeable relative to a screw spindle (32) (Figure 1 and column 4, lines 26-43). It would have been obvious to a person having ordinary skill in that art at the time of the invention to construct the invention of Saunders et al. in view of Sher et al. in further view of Gotfried with the pin being changeable relative to a screw spindle in view of Bliss in order to account for different sized holes made by the pin.

Response to Arguments

In regards to applicants argument that "Saunders fails to teach "a drill bushing, wherein the drill bushing can be removably inserted through the contact element," as recited in claim 1" and that "Huebner fails to teach or suggest the step of "screwing a

target plate to a lateral implant prior to performing a target procedure, the target plate and lateral implant being mounted on an adaptor bushing of an aiming device by a plug connection," Examiner notes that this argument is addressed by a new grounds of rejection as set forth below.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See PTO-892.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action, in particular, *inter alia*, the addition of the limitation "wherein the drill bushing can be removably inserted through the contact element." Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Larry E. Waggle, Jr whose telephone number is 571-270-7110. The examiner can normally be reached on Monday through Thursday, 6:30am to 5pm, EST..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas C. Barrett can be reached on 571-272-4746. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Larry E Waggle, Jr/
Examiner, Art Unit 3775

/Thomas C. Barrett/
Supervisory Patent Examiner, Art
Unit 3775